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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

KWOK et al.

Atty. Ref.: 4398-224; Confirmation No. 2378

Appl. No. 10/068,963

Group: 3761

Filed: February 11, 2002

Examiner: Darwin P. Erez

For: NASAL MASK AND MASK CUSHION THEREFOR

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September 24, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

Responsive to the Official Action dated June 25, 2003, please consider the following remarks.

Claims 23-99 are pending. Reconsideration in view of the following remarks is respectfully requested.

Claims 23-32 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,647,357 to Barnett et al. This rejection is respectfully traversed.

At the outset, Barnett et al. does not qualify as prior art under § 102(b). Because Barnett et al. issued on July 15, 1997, which is only one day before Applicants' earliest

effective U.S. filing date, i.e., the filing date of PCT Application No. PCT/AU97/00450 filed July 16, 1997, Barnett et al. qualifies as prior art under 35 U.S.C. § 102(e).

Turning now to the merits of the rejection, claim 23 recites a nasal mask cushion to sealingly connect a mask to a wearer's face. The cushion comprises, *inter alia*, a substantially triangularly shaped frame of resilient material having a rim to surround the wearer's nose and a membrane of resilient material.

Barnett et al. does not teach or suggest this subject matter. In the Office Action, the Examiner has taken the position that the claimed frame is body portion 12. However, Applicants respectfully submit that one of ordinary skill in the art would not have considered the body portion 12 to constitute a frame portion of the cushion. Moreover, the body portion 12 is a generally rigid formed structural shell. See column 4, lines 37-39. Accordingly, Barnett et al. does not disclose a frame of resilient material, as recited in claim 23. Similar remarks apply to claim 32.

Barnett et al. also does not teach or suggest the subject matter of dependent claims 24-31. For example, claim 24 recites that the membrane and rim each has a co-located notch to accommodate the bridge of the nose. Barnett et al. does not teach such co-located notches.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 33 was rejected under 35 U.S.C. § 103(a) over Barnett et al. This rejection is respectfully traversed for the reasons recited above, as claim 33 depends from claim

32. In addition, Barnett et al. does not teach the subject matter of claim 33 since Barnett et al. shows a frame 12 and a membrane 18 formed of two different pieces which are coupled to one another. There is no disclosure in Barnett et al. that the frame 12 and the membrane 18 can be formed in a single piece. Moreover, the frame 12 and the membrane 18 are formed of dissimilar materials (note the different cross-hatching) which would not likely be made in a single piece.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 34-39 were rejected under 35 U.S.C. § 103(a) over Barnett et al. in view of U.S. Patent No. 5,243,971 to Sullivan et al. This rejection is respectfully traversed.

At the outset, it is noted that the Sullivan et al. patent is substantially as disclosed in Prior Art Figs. 1-3 and the Background Section of the present application. Moreover, Sullivan et al. does not make up for the deficiencies noted above with respect to Barnett et al. For example, Barnett et al. does not teach or suggest a cushion assembly including a generally triangularly shaped frame of resilient material, as recited in claims 34, 36 and 38. Further, Barnett et al. does not teach the membrane including a notch in a region adapted to receive the bridge of the wearer's nose. Sullivan et al. does not make up for this deficiency.

Dependent claims 35, 37 and 39 recite that the frame and the membrane are formed in a single piece. As mentioned above, Applicants respectfully submit that it

would not have been obvious to one of ordinary skill in the art to have formed the dissimilar material frame 12 and membrane 18 of Barnett et al. in a single piece.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 23-39 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,357,441. In addition, claims 40-99 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-25 of U.S. Patent No. 6,513,526. In the Office Action, the basis for the obviousness-type double patenting rejection is that structural limitations set forth in the claims of the present application are also claimed in the respective patent. However, this is an improper basis for formulating an obviousness-type double patenting rejection because 1) the Office Action does not identify the differences between the present claims and the patented claims and 2) the Office Action does not make any assertion that it would have been obvious to one of ordinary skill in the art to have added or deleted features from the present claims to arrive at the patented claims.

Therefore, the two rejections based on obviousness-type double patenting are respectfully traversed.

In view of the above remarks, Applicants respectfully submit that all of the claims are patentable and that the entire application is in condition for allowance.

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Should Examiner Erez believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



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